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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,037	02/26/2002	Meang K. Chia	B-4496PCT 619513-8	9827

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EXAMINER

MELWANI, DINESH

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/070,037

Applicant(s)

CHIA ET AL.

Examiner

Dinesh N Melwani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 131-137 and 139-147 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 131-137 and 139-147 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgment is made of Applicant's submission of:

Amendment filed on 12/01/2003

The aforementioned item has been noted and officially inserted into the application.

Terminal Disclaimer

1. The terminal disclaimer filed on 12/01/2003 disclaiming the terminal portion of any patent granted on this application is **accepted**.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 131-134, 136, 137, 139-142, and 145-147 are rejected under 35 U.S.C. 102(b) as being anticipated by Fitzgerald (U.S. Patent No. 901, 333). Fitzgerald discloses a decorative jewelry item comprising a base member (10) having a hollow interior, a top with an opening therein leading to said hollow interior, a bottom, and a sidewall extending from said top to said bottom; and a decorative insert (Fig. 4) configured and sized in relation to said base member top opening to be inserted, through said top opening, into said hollow interior and positioned below said top; said decorative insert being fixed within said base member hollow interior with said

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decorative insert viewable through said top opening. In regards to claims 132 and 133, Fitzgerald further discloses that the decorative jewelry item (Fig. 4) comprises a support member (18) fixed to said base member within said hollow interior; and wherein said decorative insert is captured (i.e., clamped) within said base member between said base member top and said support member. In regards to claim 134, Fitzgerald's decorative insert comprises a plate-like top, see Fig. 4, and a rear projecting pin (26); said support member (18) has a hole therethrough for receiving said pin; and said pin is fixed to said support member by clamping. In regards to claim 136, said support member comprises a plate-like member fixed within said base member below said top, see Figs. 9 and 14. As it concerns claim 137, said support member (18) comprises a plate-like member fixed within said base member below said top, said plate-like support member having a hole therein through which said pin may pass, see Fig. 14. As it concerns claims 139-142, Fitzgerald discloses a method for constructing a decorative jewelry as claimed, see Figs. 1-14. In regards to claim 145, Fitzgerald discloses a base member segmented into a plurality of segments, see Fig. 9, each segment having a hollow interior, a top with an opening therein leading to said hollow interior, a bottom, and a sidewall extending from said top to said bottom; and a plurality of decorative inserts (see Fig. 2, which shows stars, a shield, and swords), each decorative insert configured and sized in relation to said segment top opening to be inserted, through said top opening, into said hollow interior and positioned below said top, each said decorative insert being fixed within said segment hollow interior with each said decorative insert viewable through said top opening. In regards to claim 146, Fitzgerald also discloses a plate-shaped insert (Fig. 4) having an upper decorative surface configured and sized in relation to the top opening to be inserted, through the top opening, into the hollow interior and positioned

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below the top; the decorative insert being fixed within the base member hollow interior and being viewable through the top opening. Regarding claim 147, said plate-shaped insert has a faceted top (Fig. 2) and a substantially flat bottom, see Fig. 3.

4. Claims 131-137 and 139-142 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheng (U.S. Patent No. 5,289,700). Cheng discloses a decorative jewelry item as claimed, wherein said item includes a base member (11), a decorative insert (16), a support member (21), and said decorative insert is captured within said base member, see Figs. 1-3C. In regards to claim 135, Cheng's decorative insert (16) comprises a plate-like top and a rear projecting pin; said support member has a hole (generally 12) therethrough for receiving said pin; and said pin is fixed within said hollow base member by a retainer affixed to said pin below said support member, whereby said pin is slidable, to a limited extent, and rotatable in said insert support member, for an enhanced visual effect.

Allowable Subject Matter

5. Claims 143 and 144 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: Claims 143 and 144 are allowable over the prior art of record because the teachings of the references taken as a whole do not show or render obvious the combination set forth, including a base member being segmented and has a multiple segmented hollow interior, a multiple

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segmented decorative insert configured and sized in relation to said multiple segmented decorative inser.

Response to Arguments

7. Applicant's arguments filed on 12/01/03 have been fully considered but they are not persuasive.

8. The Applicant contends that because Fitzgerald's decorative insert is flush with a top of box (2) is it not positioned below the top. The Examiner respectfully disagrees. As shown in Fig. 14, Fitzgerald's insert is clearly positioned below the top, however, the examiner agrees that that insert does extend upward until it is flush with the top. Therefore, the examiner asserts that Fitzgerald discloses a decorative jewelry item within the meaning of the applicant's claims.

9. The Applicant contends that Cheng's member (16) is not a decorative insert. The Examiner disagrees and asserts that it is a decorative insert. In fact, despite what the Applicant considers to be decorative, it adds aesthetic value by its mere shape being circular. Furthermore, the Applicant contends that because Cheng already has a gem (i.e., a decorative insert) it is not capable of having another. The Applicant is reminded that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Lastly, as shown in Figs. 3A-3C, Cheng's member (16) is configured and sized in relation to a base member top opening to be inserted, through said top opening, into a hollow interior and positioned below said top.

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Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinesh N Melwani whose telephone number is 703-305-4546. The examiner can normally be reached on M-F, 8:30-6 except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DNM



J. J. SWANN
SUPERVISORY PATENT EXAMINER
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